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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,563	09/25/2003	Tseng-Lu Chien	CHIE3038/BEU	4014
23364	7590	02/09/2005	EXAMINER	
BACON & THOMAS, PLLC			HAN, JASON	
625 SLATERS LANE				
FOURTH FLOOR			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314				2875

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/669,563	CHIEN, TSENG-LU
	Examiner	Art Unit
	Jason M Han	2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 25 September 2003.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-22 is/are rejected.
 7) Claim(s) 5,9,18 and 22 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 25 September 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because the length is too long.
Correction is required. See MPEP § 608.01(b).
2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The disclosure is objected to because of the following informalities:
 - a. Page 5, Line 23: Grammatical error – please rewrite to read "may be used";
 - b. Page 11, Line 17: Grammatical error – "increasing" should read as "increase";
 - c. Page 15, Line 5: Typographical error – should read as "lighting element 3";
 - d. Page 16, Line 12: Grammatical error – please rewrite to read "as an LCD clock and thermometer";

Appropriate correction is required.

Drawings

4. The drawings are objected to because Figures 7-8 refers to "Transformer 89", "DC Power Supply 81", and "Switch 20", which are different reference numbers in the specification [Pages 14-15]. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

5. Claims 5, 9, 18, and 22 are objected to because of the following informalities:
Please remain consistent in language – Applicant recites the limitation

“electroluminescent” (appropriate spelling) in Claim 2, but recites “electro-luminescent” in the abovementioned claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 12 recites the limitation "sheets" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. The examiner has no definite matter in which to base a rejection and requires elucidation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-5, 7-14, and 16-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Chien (U.S. Patent 5746501).
9. With regards to Claim 1, Chien discloses an optical effects device including a transparent optical member [Figures 2A-2C: (16, 18, 19)] having a shape which determines optical properties of the transparent member; a super thin lighting element [Figures 2A-2C: (15)]; means [Column 3, Line 48 – Column 4, Line 7] for attaching the

super thin lighting element to the transparent member; and means [Column 3, Line 48 – Column 4, Line 7] for fixing the transparent optical member relative to a main object.

10. With regards to Claim 2, Chien discloses the super thin lighting element being an electroluminescent lighting element [Column 3, Line 61] that includes electrical circuitry [Figures 4-5; Column 4, Lines 24-36].

11. With regards to Claim 3, Chien discloses the lighting element being a photoluminescent element [Column 3, Lines 23-30].

12. With regards to Claim 4, Chien discloses the optical effects device including a stuffing material [Figures 2A-2C: (18, 19)] that encloses and protects the lighting element, whereby the stuffing material is the material of foam/the optical member [Column 4, Lines 13-23].

13. With regards to Claim 5, Chien discloses the lighting element being an electroluminescent source with access to a battery and switch, whereby control circuitry for the lighting element is placed inside the stuffing [Column 4, Line 49 – Column 5, Line 21].

14. With regards to Claim 7, Chien discloses optical properties being a function of different thicknesses of the transparent member [Column 4, Lines 1-13].

15. With regards to Claim 8, Chien discloses, "Super thin lighting elements such as electro-luminescent strips or panels offer a number of advantages over conventional lighting elements such as incandescent light bulbs and light emitting diodes. These advantages include flexibility, which allows the lighting elements to follow curves on the object to which they are attached, the ability to be printed or silk-screened with logos,

marks, figures, and characters, or to be stenciled or masked, a wide variety of color choices, including green, blue, pink, yellow, and white, and low assembly and design costs [Column 1, Lines 18-28; underline added for emphasis].”

16. With regards to Claim 9, Chien discloses the lighting element including both electroluminescent and photoluminescent elements [Column 3, Lines 26-29].

17. With regards to Claim 10, Chien discloses the fixing means including means [Column 3, Line 48 – Column 4, Line 7] for fixing the transparent optical device securely to a surface of the main object.

18. With regards to Claim 11, Chien discloses the lighting element being affixed to an inside surface of the transparent optical member [Figures 2A-2C], whereby the transparent optical member [Figures 2A-2C: (16, 18, 19)] is in the form of a sheet.

19. With regards to Claim 12, Chien discloses, “combination EL and PL strips formed by mixing together EL and PL particles within a single carrier or by joining together discrete EL and PL elements [Column 3, Lines 26-30].” It is also inherent that the particles would be of different diameter particles.

20. With regards to Claim 13, Chien discloses the fixing means being stitching, ultrasonic welding, VelcroTM, press-fitting, mechanical fasteners, adhesives, or solvents [Column 4, Lines 1-23].

21. With regards to Claim 14, Chien discloses additional lighting elements facing in different directions [Figures 6-8].

22. With regards to Claim 16, Chien discloses the main object being a clock [Figures 1-8].

23. With regards to Claim 17, Chien discloses the lighting element serving as a backlight [Figures 1-8].
24. With regards to Claim 18, Chien discloses the lighting element being an electroluminescent source and the optical effects device including a self-contained housing for a battery, switch, and circuitry [Figures 4-5].
25. With regards to Claim 19, Chien discloses the circuitry being enclosed [Column 4, Lines 24-36], whereby access is available only to the switch and battery [Column 5, Lines 11-20; see also Figures 4-5].
26. With regards to Claim 20, Chien discloses the optical effects device including a plurality of main objects [Figures 1-8].
27. With regards to Claim 21, Chien discloses the main object attached to a plurality of optical effects devices, wherein the optical effects devices share a single control circuit positioned on the main object [Figure 8].
28. With regards to Claim 22, Chien discloses the lighting element including an electroluminescent element, and a power pack [Figures 5 & 8: (40)] positioned on the main object outside the optical effects device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chien (U.S. Patent 5746501) as applied to Claim 1 above.

30. With regards to Claim 6, Chien discloses the claimed invention as cited above, but does not specifically teach the transparent optical member being made of a material selected from the group consisting of polyvinyl chloride, ABS, polyethylene, polypropylene, silicone, rubber, epoxy, and PC, wherein the member includes at least one transparent area (inherent: transparent optical member).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the device out of one of the abovementioned materials, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. In this case, the above materials are suitable for transmitting light and flexible/resilient properties.

31. With regards to Claim 15, Chien discloses the claimed invention as cited above except for the main object being situated within the transparent optical member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the optical member around the main object, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. In this case, rearranging the main object within the optical member may further provide protection, as well as an aesthetic appeal.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

US Patent 3040201 to Lehmann;

US Patent 3622826 to Royce;

US Patent 4635166 to Cameron;

US Patent 5317488 to Penrod;

US Patent 5440458 to Volk;

US Patent 5559680 to Tabanera;

US Patent 5570946 to Chien;

US Patent 5720946 to Chien;

US Patent 5806960 to Chien;

US Patent 5806960 to Chien;

US Patent 5876108 to Cross;

US Patent 5921653 to Chien;

US Patent 6030089 to Parker et al;

US Patent 6106127 to Fuwusa;

US Patent 6116745 to Yei;

US Patent 6637906 to Knoerzer et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (2/4/2005)



JOHN ANTHONY WARD
PRIMARY EXAMINER